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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,453	12/19/2005	Mehmet Toner	50254/005002	8260

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CLARK & ELBING LLP  
101 FEDERAL STREET  
BOSTON, MA 02110

EXAMINER
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WARE, DEBORAH K

ART UNIT	PAPER NUMBER
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1651

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/05/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/529,453

Applicant(s)

TONER ET AL.

Examiner

Deborah K. Ware

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16-19, 21-29, 44-46 and 48-118.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-19, 21-29, 44-46 and 48-118 is/are pending in the application.
- 4a) Of the above claim(s) 16-19, 21-29, 51-46, and 48-116 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 44-50, 117 and 118 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 16-19, 21-29, 44-46 and 48-118 are pending.

#### ***Preliminary Amendment***

The preliminary amendment filed March 28, 2005, was received and entered. However, claim amendments filed on August 16, 2006 were not entered, but the claim amendments filed on October 12, 2006 were received and entered.

#### ***Election***

Applicant's election with traverse of Group V in the reply filed on October 12, 2006 is acknowledged. The traversal is on the ground(s) that unity of invention exists. This is not found persuasive because the various microfluidic devices claimed are not required by the method of Group V. Although a microfluidic device is required of Group V it is not necessarily the same device of the other Groups. The commonality of the special technical features is obscured in the language of the claims and as such no common technical feature is noted between the method of Group V and the other Groups.

The requirement is still deemed proper and is therefore made FINAL.

Claims 16-19, 21-29, 51-46, and 48-116 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on August 16, 2006.

Claims 44-50 and 117-118 are examined on the merits.

***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on January 27, 2006, October 4, 2006 and October 27, 2006 were received. The submissions are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 44-50 and 117-118 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Spence et al (US2002/0005354A1), cited on enclosed PTO-892 Form.

Claims are drawn to method of producing a cell population enriched in a first cell type comprising subjecting blood sample to separation comprising contact with a microfluidic channel comprising obstacles so that smaller cells are directed in one direction and larger cells are directed in another second direction and separation comprising contact with the device to produce an enriched cell population.

Spence et al teach a method of producing a cell population enriched in a first cell type, note page 3, column 1, line 4, and page 5, column 2, [0054], line 15 and page 8, column 1, [0078] lines 1-2 and column 2, [0082], all lines. The microfluidic device is disclosed.

The claims are identical to the cited disclosure and are, therefore, considered to be anticipated by the teachings of the reference. The binding moiety is in the disclosed coatings of the reference because the cells will inherently bind to the coating of the disclosed chip. Further, the blood cells can be human which includes fetal blood cells. The percentage of cells which can selectively bind can be accurately controlled by the microprocessor disclosed to be on the chip of the reference. Also the two dimensional array is disclosed by the reference since there is more than one channel. Further, the

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direction is disclosed to be reversible and so the property of preferential reversible binding is an inherent feature of the disclosed chip.

In addition, the reference discloses a window at page 8, [0081], line 5, which can inherently function to serve as a field for actuating preferential binding as necessary when flow is in the reverse. However, in the alternative that there is some unidentified claimed difference then this difference is considered to be so slight as to render the claims prima facie obvious over the cited prior art. It would have been obvious to design the program of the disclosed device to provide for 60% of the first type and 70% of cells of the second type, and further to provide for a binding moiety to control flow in a two-dimensional array. Also to select for a fetal cell is clearly within the guidance of the description of the cited reference. The claims are at the very least prima facie obvious over the cited prior art.

All claims fail to be patentably distinguishable over the state of the art discussed above and cited on the enclosed PTO-892 and/or PTO-1449. Therefore, the claims are properly rejected.

The remaining references listed on the enclosed PTO-892 and/or PTO-1449 are cited to further show the state of the art.


No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah K. Ware whose telephone number is 571-272-0924. The examiner can normally be reached on 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
**DEBORAH K. WARE**  
**PATENT EXAMINER**

Deborah K. Ware  
December 23, 2006